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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIP N. BANERJEE and
RABINDRANATH DUTTA

Appeal 2009-013402
Application 09/965,152
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 12, 23, and 34-36 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to methods of distributing products through automatic product dispensing machines (Spec. 1:6-9). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter of appeal.

1. A method for providing products, the method comprising:
 - receiving, at a first automatic product/service dispensing machine at a location in a micronetwork of proximally located diverse automatic product/service dispensing machines, a request for an item by a user;
 - receiving at the first automatic product/service dispensing machine, a payment device of the user, wherein the payment device includes identity information;
 - responsive to a determination that the item is unavailable at the first automatic product/service dispensing machine, providing the user with redirection information regarding a location of at least one alternative automatic product/service dispensing machine in the micronetwork at which the item may be obtained;
 - [1] requesting the user to select a second automatic product/service dispensing machine among the at least one alternative automatic product/service dispensing machine;
 - [2] responsive to the user selecting the second automatic

product/service dispensing machine, providing the identity information and notice of a discount value to be given to the user for the item to the second automatic product/service dispensing machine; and

[3] responsive to receiving the payment device of the user at the second automatic product/service dispensing machine, the second automatic product/service dispensing machine dispensing the item and deducting the discount value from a price of the item, wherein the user is charged a reduced price for the item at the second automatic product/service dispensing machine.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Powell	US 5,956,694	Sep. 21, 1999
Moore	US 7,084,737 B1	Aug. 1, 2006
Walker	US 7,249,050 B1	Jul. 24, 2007

The following rejections are before us for review:

1. Claims 1, 12, 23, and 34-36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Walker, and Powell.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether it would have been obvious to combine Moore, Walker, and Powell to meet the claim limitations which have been argued for by the Appellants.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Moore has disclosed a method for locating a nearby alternate vending machine for a desired product (Title). When a product is not available at a first vending machine, the first vending machine conveys the location of a nearby, alternate vending machine to the customer (Abstract, Col. 1:42-56)

FF2. Moore at Col. 2:1-50, Walker at 2:63-3:6, 4:40-45, 18:45-50, 15:55-67, and Powell at 6:1-50 does not disclose requesting the user to select a second automatic dispensing machine among at least one alternative automatic dispensing machine.

FF3. Walker has disclosed a vending machine which encourages the purchase of profitable items (Title).

FF4. Walker discloses that the vending machine offers substitute products when the original item is out of stock (Col. 2:63-3:6). Walker discloses that the user may be offered a discount or coupon code for making an alternate product purchase (Col. 15:34-67).

FF5. Powell has disclosed a method for distributing and processing discount coupons (Title) using a smart card to store electronic coupons (Abstract).

ANALYSIS

The Appellants argue that the rejection of claim 1 is improper because the prior art fails to disclose or suggest claim limitation [1] (Br. 13-14).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In contrast the Examiner has determined that the rejection of record is proper (Ans. 6-9). The Examiner has acknowledged that Moore fails to disclose claim limitation [1] (Ans. 3-4) but asserts that the combination of Moore, Walker, and Powell would render the cited claim limitation [1] obvious (Ans. 6-7).

We agree with the Appellants. Claim limitation [1] requires:

[1] requesting the user to select a second automatic product/service dispensing machine among the at least one alternative automatic product/service dispensing machine (Claim 1, emphasis added).

Thus, the cited claim limitation [1] requires in part “*requesting the user to select a second automatic....dispensing machine*” and support for this limitation is provided in the Specification (Spec. 8:4-9:10). The Examiner has acknowledged that Moore fails to disclose this cited claim limitation [1] (Ans. 3-4). The portions of Moore which have been cited by the Examiner show that when a product is not available at a first vending machine, the first vending machine conveys the location of a nearby, alternate vending machine to the customer (FF1) but Moore at the sections cited does *not* disclose *requesting the user to select a second automatic dispensing machine among at least one alternative automatic dispensing machine* (FF2) as claimed. Walker discloses a vending machine that offers substitute products when the original item is out of stock and offering a discount or coupon code for making an alternate purchase (FF4) and Powell has disclosed a processing discount coupon using a smart card (FF5) but at the portions cited by the Examiner, neither reference discloses requesting the user to select a second automatic dispensing machine (FF2). Claim 1 does not require merely providing the user with the location of another dispensing

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machine that has the product, it also requires *requesting the user to select a second dispensing machine* among at least one alternative dispensing machine as cited in claim limitation [1], and then responsive to such a selection providing a discount value as recited in claim limitation [2]. Claim 1 specifically requires “*requesting the user to select a second automatic....dispensing machine*” and the rejection of record fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness to meet the cited claim limitation by making such a modification. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). For these reasons the rejection of claim 1 is not sustained. Independent claims 12, 23, and their dependent claims, contain a similar limitation and the rejection of these claims is not sustained for these same reasons.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 12, 23, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Moore, Walker, and Powell

DECISION

The Examiner’s rejection of claims 1, 12, 23, and 34-36 is reversed.

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REVERSED

MP

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